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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,654	09/10/2003	Gregory A. Piccionelli	39003.811US01	3656

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EXAMINER

COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/659,654	Applicant(s) PICCIONELLI ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 2-9, 11-18 and 29-32 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 2-9, 11-18 and 29-32 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input checked="" type="checkbox"/> Other: <u>Search History</u> . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 29 March 2010 has been entered.

Acknowledgements

2. This Office Action is in reply to Applicants' original application filed 29 March 2010 ("2010 Mar Response").
3. Claims 2-9, 11-18, and 29-32 are currently pending and have been examined.
4. Based on a comparison of Pre-Grant Publication No. U.S. 2004/0054555 A1 ("PGPub") with Applicants' originally submitted specification, the PGPub appears to be a fair and accurate representation of the Applicants' original specification. Therefore, when necessary and unless expressly noted otherwise by the Examiner, references in this Office Action to Applicants' original specification will refer to paragraph numbers in the PGPub (*e.g.*, [0043]).
5. This Office Action is assigned Paper No. 20111107. This Paper No. is for reference purposes only.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, each step of the method claims must be shown or the features canceled from the claims. No new matter should be entered.

7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the Applicants will be notified and informed of any required corrective action in the next Office Action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC §112, First Paragraph

8. The following is a quotation of the first paragraph of 35 U.S.C. §112:

(a) The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 2-9, 11-18, and 29-32 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

10. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Regarding Claims 2-9, 11-18, and 29-32

11. Claim 9 recites (in part) “f) examining the reason for the charge-back request, g) determining that the reason for the charge-back request includes an assertion that the user did not request membership in the site, and h) denying the charge-back request based on the determination in step g).” The Examiner has carefully reviewed Applicants’ original disclosure and cannot locate support for the above limitations.

12. The Examiner finds the closest support residing in [0025] of the original specification. In [0025], Applicants state “The inventive method effectively reduces the incidence of fraudulent charge-backs, in that if a user wishes to charge back the membership in the program, the user must also return the associated tangible good. Consequently, a major basis on which users fraudulently request charge-backs, namely that the users have not actually joined the program with which the web site is associated, is removed. Once the tangible good has been returned, then a charge-back can legitimately be processed. However, the probability that the claim will be based on an assertion of a fraudulent charge will be significantly reduced or eliminated, since

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records will exist of the tangible good having been shipped to, and likely received and signed for by, the user.” However, this portion of the Applicants’ original specification does not support the method steps referenced above. Applicants have provided insufficient description to support a step of “examining...,” a step of “determining...,” and a step of “denying....” The original disclosure does not sufficiently recite the aforementioned steps, let alone describe how these steps are performed. The Examiner also finds that [0025] of Applicants’ original specification is directed to membership in a program. In contrast, the claims are directed to membership in a website. The Examiner finds insufficient evidence to support that the “program” is equivalent to the “website.” In fact, Applicants themselves distinguish the program from the website in [0024] of the original specification.

13. Claim 29 recites limitations similar to those discussed above with respect to claim 9. Accordingly, claim 29 and dependents thereof are rejected for reasons similar to those above.

Claim Rejections - 35 USC §112, Second Paragraph

14. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 6-9, 11-18, and 30-32 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

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Regarding Claims 9, 11-18, and 31

16. Claim 9 recites "... accessing an affiliate site on a network the affiliate site including a hyperlink to the destination site" Claim 9 is indefinite because the meaning of the phrase "an affiliate site on a network the affiliate site" is unclear.

Regarding Claims 6 and 16

17. Claim 6 recites "The method of claim 29 wherein in step b) a tangible good is provided to the user periodically." Moreover claim 29 recites (in part) "... b) shipping a tangible good associated with the membership in the site to the user" Claim 6 is indefinite because it is unclear whether the "a tangible good" recited in claim 6 is referring to the same "a tangible good" recited in claim 29 or to a separate tangible good.

18. Claim 16 recites similar limitations to those discussed above. Accordingly, claim 16 is rejected for reasons similar to those discussed above.

Regarding Claims 7 and 17

19. Claim 17 recites "The method of claim 9 wherein the membership in the destination site is renewed periodically." Claim 17 is indefinite because it is unclear whether the "wherein the membership in the destination site is renewed periodically" is a positively recited method step.

20. Claim 7 recites similar limitations to those discussed above. Accordingly, claim 7 is rejected for reasons similar to those discussed above.

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Regarding Claims 8 and 30

21. Claim 30 recites “The method of claim 29 wherein a user acquiring the membership in the site is associated with a password that identifies the user and the site.” Claim 30 is indefinite because it is unclear whether the “wherein a user acquiring the membership in the site is associated with a password that identifies the user and the site” is a positively recited method step.

22. Claim 8 recites similar limitations to those discussed above. Accordingly, claim 8 is rejected for reasons similar to those discussed above.

Regarding Claims 31 and 32

23. Claim 31 recites “The method of claim 9 wherein the electron-based service is a membership in the destination site.” Claim 31 is indefinite because it is unclear to what the “the electron-based service” is referring.

24. Claim 32 recites similar limitations to those discussed above. Accordingly, claim 32 is rejected for reasons similar to those discussed above.

25. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

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Claim Rejections – 35 U.S.C. § 103

26. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 2-9, 11-18, and 29-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Richey et al. (U.S. 2003/0233292 A1) (“Richey”), in view of Perri, III et al. (U.S. 2001/0020231 A1) (“Perri”), and in further view of Moore (U.S. 6,847,938 B1).

Regarding Claims 9 and 29

28. Richey discloses:

- b) shipping a tangible good associated with a merchant ([0056] [0086] [0087]),
- c) creating a record of the shipment of the tangible good to a user (the creation of the record is *inherent* to the disclosure of Richey’s “merchandise delivery data”; if the data exists, then the creating function is *necessarily present* – [0056] [0086] [0087]),
- d) receiving a charge-back request from the user, the charge-back request comprising a reason for the charge-back request (fig. 1 – “2. Cardholder initiates dispute,” fig. 7),
- e) associating the charge-back request with the record of the shipment of the tangible good to the user ([0086]),
- f) examining the reason for the charge-back request (fig. 5, [0088]),

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g) determining that the reason for the charge-back request includes an assertion that the user did not request the tangible good (see at least fig. 7, *e.g.*, “Cardholder Does Not Recognize Transaction”; [0074]);

h) denying the charge-back request based on the determination in step g) (fig. 7, *e.g.*, “Cardholder Does Not Recognize Transaction”; [0089] discussion of “representments”; see also discussion of figures 3a, 3b).

Richey does not directly disclose:

a) providing a membership in a destination site on a network to a user requesting the membership, wherein the user requests the membership by i) accessing an affiliate site on a network the affiliate site including a hyperlink to the destination site, and ii) accessing the destination site by activating the hyperlink,

shipping a tangible good associated with the membership in the destination site to the user; and

determining that the reason for the charge-back request includes an assertion that the user did not request the membership in the site.

29. Perri teaches a) providing a membership in a destination site on a network to a user requesting the membership, wherein the user requests the membership by i) accessing an affiliate site (*e.g.*, [0077] “banner ad on a website”) on a network the affiliate site including a hyperlink (*e.g.*, [0015] “link”) to the destination site, and ii) accessing the destination site by activating the hyperlink (*e.g.*, [0015] “selecting the link”) (see at least [0009] [0015] [0010] [0053]-[0056] [0076] [0077]).

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30. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Richey's method to include the merchants of Richey providing memberships in the manner taught by Perri. One would have been motivated to do so because this would allow the merchants of Richey to compensate referring members (Perri [0056]).

31. Moreover, Moore teaches shipping a tangible good associated with a membership in a destination site to a user (4:61 – 5:26).

32. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify at least one merchant of Richey to offer the membership taught by Moore and modify Richey's method to include the shipping of tangible goods associated with the membership taught by Moore. One would have been motivated to do so in order to financially benefit from beginning together parties to an exchange.

33. Moreover, the Examiner finds (when combining Richey with Moore) that a member of Moore would be capable of using the system of Richey to assert that the user (*i.e.*, member) did not request the membership in the site, *e.g.*, by disputing the charge for the membership fee discussed in 4:61 – 5:26. A member of Moore could make this assertion using the "Cardholder Does Not Recognize Transaction" option of Richey (see at least fig. 7). Therefore, the Examiner finds the combination of Richey and Moore to read on the claimed "determining that the reason for the charge-back request includes an assertion that the user did not request the membership in the site."

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Regarding Claims 2-8, 11-18, and 30-32

34. The combination of Richey, Perri, and Moore discloses the limitations of claim 9, as shown above, and further discloses the limitations of:

a. At least Claim 11: The method of claim 9 wherein the tangible good is a digital storage device (Moore: 4:61 – 5:26);

b. At least Claim 12: The method of claim 11 wherein the digital storage device is a CD-ROM (Moore: 4:61 – 5:26);

c. At least Claim 13: The method of claim 12 wherein the CD-ROM includes at least one digital data file (Moore: 4:61 – 5:26);

d. At least Claim 14: The method of claim 13 wherein the digital data file is selected from the group consisting of an audio file, a video file, a photographic file, a graphic file and a text file (Moore: 4:61 – 5:26);

e. At least Claim 15: The method of claim 12 wherein the CD-ROM includes a hyperlink to a third- party site or a network (Moore: 4:61 – 5:26; hyperlink is nonfunctional descriptive data);

f. At least Claim 16: The method of claim 9 wherein in step b) a tangible good is provided to the user periodically (Moore: 4:61 – 5:26);

g. At least Claim 17: The method of claim 9 wherein the membership in the destination site is renewed periodically (Perri [0076] [0077]);

h. At least Claim 18: The method of claim 9 further comprising the step of providing a valuable consideration to the affiliate site after step b) (Perri, at least abstract);

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i. At least Claim 30: The method of claim 29 wherein a user acquiring the membership in the site is associated with a password that identifies the user and the site (Perri [0065]); and

j. At least Claim 31: The method of claim 9 wherein the electron-based service is a membership in the destination site (Moore: 4:61 – 5:26).

Claim Interpretation

35. Unless expressly noted otherwise by the Examiner, the Examiner maintains his position on claim interpretation as noted in Paragraph Nos. 28-31, Paper No. 20090916.

Response to Arguments

36. Applicants' arguments with respect to the examined claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

37. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does not constitute a formal requirement mandated by the Examiner.

k. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants

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to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112, ¶1.

1. Independent of the requirements under 35 U.S.C. § 112, ¶1, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does not have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims do have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

38. The prior art made of record which is considered pertinent to Applicants’ disclosure is listed on the document titled ‘Notice of Reference Cited’ (“PTO-892”) Unless expressly noted otherwise by the Examiner, all documents listed on the PTO-892 are cited in their entirety.

39. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on

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Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
08 November 2011